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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/928,942 | 08/13/2001 | Margaret Jane Burton | 10006708-1 | 8090 |

7590 11/04/2004

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

GREENE, DANIEL L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3621

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/928,942

Applicant(s)

BURTON ET AL.

Examiner

Daniel L. Greene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 9/16/2004 have been fully considered but they are not persuasive. The Applicant argues that Wyman fails to show or suggest maintaining the licensors and licensees in a server. As per figure 1, **10**, is a license server containing client (licensee) **31** and license database (licensor) **23** data.
2. The Applicant further submits that Wyman does not show or suggest the concept of maintaining a profile for each of the entities, where the profiles include a point of contact for a given entity. As per Figure 2, the Product Use Authorization shows the sections that have the information/profile of the entities. (Licensee **38**).
3. The Applicant further submits that Wyman that a license is generated based upon the unilateral input of a licensee or a licensor. Wyman discloses the concept of LURDM or license unit requirement determination method. Col. 17, lines 35-60, and the generation of the LURT, license unit requirements table, Col. 17, lines 45-55, which requires unilateral input of a licensee and a licensor.
4. The Applicant further submits that Stefik does not teach or suggest the concept of modifying the first one of the profiles and notifying a respective one of the entities party to a license with an entity for which a profile has been altered. Stefik discloses the notations and notifications done when a transaction is completed. Col. 35, lines 1-67.
5. In reference to the Applicant's request that specific citation of how the cited references show or suggest the elements of the instant claims is proper the Examiner submits, "A reference is to be considered not only for what it expressly states, but for

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what it would reasonably have suggested to one of ordinary skill in the art. *In re DeLisle*, 160 USPQ 806 (CCPA 1969)". The Examiner provides insights into the sections pertaining to the instant claims in the reference without negating the rest of the references information pertaining to the instant claims.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wyman U.S. Patent 5,260,999 [Wyman] , and further in view of Stefik et al. U.S. Patent 6,714,921 [Stefik].**

3.

The recitation that a system, a method, and a computer-readable medium has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a method, a system, an apparatus, etc. and the portion of the claim following the preamble is a self-contained description of the method or the system, etc., not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951)

As per claims 1, 9, and 17:

Wyman discloses:

maintaining a number of entities in the license repository in a server, the number entities including a number of licensors and a number of licensees; Col. 6, lines 43-67.

generating a number of licenses between respective pairs of the licensees and the licensors based upon an input from at least one of the licensees 10 and the licensors, respectively; Col. 7, lines 49-67

maintaining the licenses in the license repository. Col. 10, lines 30-55.

Wyman discloses the claimed invention except for the use of the term Repository. Stefik teaches that it is known in the art to provide a repository for maintaining the licenses. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the storage of the licenses of Wyman with the storage of the licenses in a repository of Stefik, in order to further clarify the storage function.

As per claim 2, 10, and 18:

Wyman further discloses:

wherein the step of maintaining the number of entities in the license repository in the server further comprises maintaining a profile for each of the entities, each of the

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profiles including point of contact for at least one of the entities in the license repository.

Col. 20, lines 28-35.

As per claims 3, 11, and 19:

Wyman further discloses:

wherein the step of generating the number of licenses between respective pairs of the licensees and the licensors based upon the input from the at least one of the licensees and the licensors, further comprises: Col. 11-12, lines 1-67.

generating a first one of the licenses based upon a unilateral input by a first one of the entities; Col. 11-12, lines 1-67.

notifying a second one of the entities that is party to the first one of the licenses of the creation of the first one of the licenses. Col. 11-12, lines 1-67.

As per claims 4, 12, and 20:

Wyman further discloses:

further comprising maintaining a confirmation status of at least one of the licenses in the license repository. Fig. 27.

As per claims 5, 13, and 22:

Wyman discloses the claimed invention except for the modifying a first one of the profiles in the license repository based upon a modification input received from a first

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one of the entities; and notifying a second one of the entities that is party to one of the licenses with the first one of the entities of the modifying of the first one of the profiles.

Stefik teaches that it is known in the art to provide modifying a first one of the profiles in the license repository based upon a modification input received from a first one of the entities; and notifying a second one of the entities that is party to one of the licenses with the first one of the entities of the modifying of the first one of the profiles. Col. 41-42, lines 1-67.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the registration function of Wyman with the modifying a first one of the profiles in the license repository based upon a modification input received from a first one of the entities; and notifying a second one of the entities that is party to one of the licenses with the first one of the entities of the modifying of the first one of the profiles of Stefik, in order to facilitate the tracking of the use of the selected program..

As per claims 6, 14, and 23:

Wyman further discloses:

updating the confirmation status of the at least one of the licenses based upon a confirmation status input received from one of the entities. Col. 21-22, lines 1-67.

As per claims 7, 15, and 21:

Wyman further discloses:

maintaining a number of license products associated with at least one of the licensors in the license repository. Col. 24-25, lines 1-67.

As per claims 8, 16, and 24:

Wyman further discloses:

an additional one of the number of license products in the license repository based upon a license product input from the at least one of the licensors. Col. 28, lines 35-67.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 703-306-5539. The examiner can normally be reached on M-Thur. 8am-6pm.

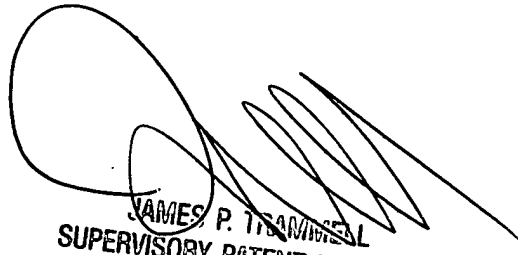
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10/28/2004

DLG



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNICAL CENTER 3621